

REMARKS

Claims 1-29 continue to be the pending claims in this application.

Reconsideration of this application in light of the remarks that follow is respectfully requested.

Double Patenting Rejection

Claims 1-29 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,708,456 in view of CANFIELD et al. (U.S. Patent No. 4,567,079). The Examiner alleges that the '456 patent contains all the presently claimed features but fails to disclose an adhesive coating on one side of the interply material to secure the roofing product to the roof deck. The Examiner contends that CANFIELD et al. teaches a roofing assembly that comprises a roof deck, over which a plurality of ply sheets are applied and bonded by means of a bonding agent and that it would have been obvious to modify the roofing composite of the '456 patent to provide an adhesive coating in view of CANFIELD et al.

The Claimed Invention

Claims 1 through 29 cover a composite roofing product comprising a roofing material, an interply material attached to the roofing material along an edge of the roofing material to permit a major portion of the interply material to be folded away from the roofing material, and an adhesive coating on one side of the interply material, wherein the adhesive coating serves to secure the roofing product to a roof deck. Thus, the present invention provides an all-in-one roofing product that may be readily installed on a roof deck.

In a preferred embodiment, the roofing material of the present invention is a roofing shingle or roll roofing and the interply material is an underlayment material. The interply material comprises an adhesive coating on one side which may be covered with a release material so that the adhesive is not exposed until the release material is removed and the roofing product is applied to a roof deck.

All of the pending claims cover a composite roofing product comprising an interply attached to a roofing material wherein the interply comprises the adhesive coating on one side. None of the art cited in the Official Action, whether considered alone or in combination, disclose or suggest such a roofing product.

The Prior Art

U.S. Patent No. 6,708,456, of which the present application is a continuation-in-part does not disclose an adhesive coated-interply material, although it does disclose a roofing product comprising a roofing material attached to an interply material along one edge of the roofing material. The roofing product of the '456 patent is installed on a roof deck by conventional methods, for example by the use of fasteners, such as nails or staples.

CANFIELD et al. discloses a roofing membrane comprising perforations. The roofing membrane is applied to a roof deck by applying a bonding agent, which has been heated so that it flows, to the membrane at the site of the perforations or to the roof deck during the installation of the roofing membrane on the roof deck. The bonding agent can bond the membrane to the roof deck and to an overlapping membrane laid over the site of the perforations because the perforations allow the heated bonding agent to pass through

the membrane and contact not only the roof but a subsequent layer of membrane laid over a previous membrane layer. *See* CANFIELD et al. col. 2, lines 30-34 and lines 65-67. The installed bonded membrane is then coated with a final asphalt coat or capped with asphalt embedded with gravel or other granular material or finished with another weather resistant coating, alternatively, the coating or capping may be applied prior to the installation of the membrane to the roof deck. *See* CANFIELD et al. col. 2 lines, 34-38, and col. 4, lines 50-55. CANFIELD et al. does not disclose or suggest an interply material comprising an adhesive coating, nor does it disclose or suggest an interply material that is attached to a roofing material along an edge of the roofing material.

There is No *Prima Facie* Case of Obviousness

The '456 patent and CANFIELD et al. do not support a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation in the cited references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the combined references must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and must not be based on the Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991); MPEP § 2142.

In this case, there is no suggestion or motivation in any of the cited references to alter '456 patent to produce a roofing product comprising a roofing material, an interply material and an adhesive coating on one side of the interply material.

CANFIELD et al. disclose a roofing membrane having perforations. The roofing membrane is applied to a roof deck by the use of a heated, flowing bonding agent which can flow through the perforations of the roofing membrane allowing the membrane to bond to the roof deck and to a subsequent membrane laid over a previous layer of the roofing membrane. At best, the combination of the '456 patent and CANFIELD et al. would result in a roofing product comprising a roofing material, such as a roofing shingle, and a perforated roofing membrane, wherein the roofing product is installed on the roof deck by applying a heated, flowing bonding agent at the site of the perforations of the membrane. The combination of the '456 patent and CANFIELD et al. would not result in the presently claimed roofing product comprising a roofing material, an interply material and an adhesive coating on one side of the interply material. The present invention eliminates the need for the use of a heated, flowing bonding agent and provides a roofing product that includes everything necessary for the application of the product to a roof deck and may be readily installed without the need for fasteners or a bonding agent that must be heated to a flowing state at the installation site. Thus, ease of installation is achieved.

Correspondingly, Applicants further submit that there is no double patenting issue. The claims of the instant application are distinct from and nonobvious in view of the '456 patent. As noted by the Examiner in the Official Action, the '456 patent does not teach or suggest a roofing product comprising a roofing material, an interply material and

an adhesive coating on the interply material. Nonstatutory-type double patenting prohibits claims in a second patent that are not patentably distinct from claims in a first patent. *See* MPEP 804. Applicants assert that the present claims are patentably distinct from the claims of the '456 patent. Moreover, CANFIELD et al. does not provide the teaching or suggestion of such an adhesive coating on an interply material to support the Examiner's rejection of the claims based on obviousness-type double patenting over the '456 patent in view of CANFIELD et al.

However, to advance allowance of the present application, Applicants submit concurrently herewith a Terminal Disclaimer, disclaiming any portion of the term of the present application that would extend beyond the expiration date of the '456 patent. Therefore, Applicants respectfully request withdrawal of the rejection of claims 1-29 under the judicially created doctrine of double patenting.

Conclusion

Applicants submit that the claims are now in condition for allowance. Favorable reconsideration of the claims is therefore respectfully requested.

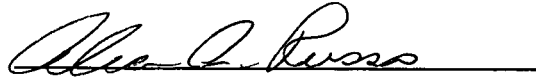
Applicants believe no fee is due in connection with this communication. However, should any fee be due in connection with this communication, the Commissioner is hereby authorized to charge any such fee to Deposit Account No. 06-1205.

Attorney Docket No. 03137.000003.

PATENT APPLICATION

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "John D. Murnane", is written over a horizontal line.

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